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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/095,323	06/10/98	LAUFER	031211-0

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QM12/0719

EXAMINER  
SHAY, B

ART UNIT	PAPER NUMBER
3739	

07/19/01  
DATE MAILED:

*16*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.	09/095,323	Applicant(s)	Laufers
Examiner	D. Day	Group Art Unit	3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on April 27, 2001.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-51 is/are pending in the application.

Of the above claim(s) 1-27, 48 & 49 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 28-47, 50, & 51 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 948

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other \_\_\_\_\_

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29, 30, 34, 35, 39, 40, 44, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29, 34, 36, 35, 39, 40, 44, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29, 34, 36, 35, 39, 40, 44, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 51 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clarke.

Claims 28-47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke. Clarke teaches a method of killing smooth muscle cells (see column 2 lines 16-50) using ultraviolet radiation in the 240-~~200~~<sup>280</sup> nanometer range (see the paragraph bridging column 2 and 3 for example). It would have been obvious to the artisan of ordinary skill to employ the method in bronchial tissue, esophageal tissue or urethral tissue since these are equivalents and are all composed of smooth muscle cells that respond to the same irradiative methods as blood vessels, official notice of which has already been taken; to employ a radioactive source, since these are notorious equivalents to laser radiation for killing smooth muscle cells, official notice of which has already been taken; and to use other wavelengths since the media is highly

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absorbant, official notice of which is hereby taken, to employ the method on long lessions, which would require movement while irradiating, since lesions which cover long portions must be treated as well, and to employ the method in an astmatic lung, since there is no indication that the smooth muscle cells therein would respond any differently than in non astmatic lung thus producing a method such as claimed.

Applicants assertions regarding claims '28-32, 34,35, 39, 43, 44, and 45" for failing to recite how they manipulatively affect the method are noted. The examiner must first point out that claims 28-32 were not rejected for this reason<sup>s</sup>, but based on the apparent omission in claim 28, as set forth on page 2 of the previous Office action. Applicants remarks regarding the understanding of the claims scope are also noted. However, the examiner further notes that it is well understood that "To be entitled to weight... structural limitations must effect the method in a manipulative sense, and not amount to the mere claiming of use of a particular structure. "Ex Parte Pfeiffer, 782. O.G. 639, 1962 CD 408. Applicant has demonstrated no manipulative difference in the attaching of the applicator to a red ligh source, rather than a 245-280 in light source, thus the rejection has been maintained.

The arguments drawn the Dierksman reference are noted, but are not convincing. The examiner notes that the killing of smooth muscles cells in the method of Clarke will, via the removal of these dead cells through natural bodily processes, result in debulking of the tissue over time (see Figures 6B and 6C of Clarke). Thus applicant's arguments are not convening .

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Applicant's arguments with respect to claims 28-47, 50, and 51 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
June 26, 2001

  
DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330